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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,325	08/02/2001	Robert M. Scarborough	044481-5060-01-US	5032

9629 7590 07/14/2003

MORGAN LEWIS & BOCKIUS LLP  
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WASHINGTON, DC 20004

EXAMINER
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KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/14/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,325

Applicant(s)

Scarborough et al.

Examiner

Bruck Kifle, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 9, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 23-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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Applicant's amendments and remarks filed 5/9/03 have been received and reviewed.

Claims 23-38 are now pending in this application.

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***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: The prior US application is identified as 09/755,812 which is in error. The correct serial number of the parent application is 09/775,812.

See also the first paragraph of the specification which identifies the wrong application. Applicants need to correct this because the error remains. Note, the prior application serial number should be 09/775,812 filed 02/05/2001, not 09/755,812.

***Claim Rejections - 35 USC § 112***

Claims 23-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding the terms "heteroaryl", "heterocyclic" and "substituted", Applicants point to various pages of the specification. These definitions should be included within the claims.

The claims measure the invention. *United Carbon Co. v. Binney & Smith Co.* 55 USPQ 381 at 384, end of first paragraph, Supreme Court of the United States (1942).

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The U.S. Court of claims held to this standard in *Lockhead Aircraft Corp. vs. United States*, 193 USPQ 449, "claims measure the invention and resolution of invention must be based on what is claimed."

The CCPA said "that invention is the subject matter defined by the claims submitted by the applicant". "We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim" (In re Priest, 199 USPQ 11 at 15).

Therefore Applicants need to indicate in the claim what is intended.

Regarding "prodrug", Applicants point to a text book like definition. However, one skilled in the art cannot say which derivative of the compound would be a prodrug. How is this prodrug made (paragraph 1) and what does it look like? Arriving at a prodrug of a given active compound is a research project.

Applicants are again advised that claims 26-30 are duplicates of each other and claims 31-35 are duplicates of each other. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Note, the intended use of a pharmaceutical composition does not have any patentability weight. It is again suggested to rewrite claim 26 as, for example,

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“A pharmaceutical composition comprising a therapeutically effective amount of a compound according to claim 23, or a pharmaceutically acceptable salt thereof, and a pharmaceutically acceptable carrier.”

Similar claim language for claim 31 is also suggested.

Applicants argue that the claims are further limiting. However, all of the compounds are taught to be effective platelet ADP receptor inhibitors (see page 2, lines 10-18). How can one say which compound of claims 27-30 (or claims 32-35) is not embraced by claim 26 (or claim 31)?

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

July 11, 2003



**Bruck Kifle**  
**Primary Examiner**  
**Art Unit 1624**